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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/748,374

12/27/2000

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1466.1024

3846

21171 7590 08/13/2008

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

08/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### DETAILED ACTION

1. This office action is in response to communication filed on 5/27/2008.
2. Claims 2-3, 5-8 are presented for examination.

#### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based on Supreme Court precedent <sup>1</sup> and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. <sup>2</sup> If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

**Claims 6 and 8** are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as “receiving... issuing .....recording ...transmitting”, the applicant has not recited an apparatus or device to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

In claim 6 and 8 the steps are related to a mental process, which is not patentable. Indeed, it is not tied to another statutory class or does not change or switch

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statutory class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*.

Examiner suggests applicant inserts a device in one or more steps of the body of the claims in order to overcome this rejection.

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<sup>1</sup> Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda (5,937,391 hereinafter Ikeda) in view of Walker et al. (6,338,049 hereinafter Walker).

With respect to claims 2, 5-8, Ikeda teaches a recording medium storing a program for a point-service system that can be accessed by a customer using a terminal device via a network (Abstract).

receiving from the customer, a request for an arbitrary number of reserved points from

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among a number of points accumulated in any one of a plurality of point-use facilities issuing points to the customer (Figure 6);

Recording the requested arbitrary number of reserved points from among the accumulated number of points based upon the request for the arbitrary number of reserved points (Figure 16);

transmitting data of a point use ticket, comprising the entered requested arbitrary number of reserved points from among the accumulated number of points to the terminal device for issuance of the point use ticket the requested arbitrary number of reserved points (points redeeming unit 3);

determining a point use ticket is usable by verifying a reference request for the arbitrary number of reserved points from a point usable facility transmitting the number of reserved points based upon the status of the reserved points the verifying being conducted by comparing the number of reserved points to the point use ticket to be referred with the recorded requested arbitrary number of reserved points and the verifying including verifying a use status of the number of reserved points (see figures 8-9, 14,16).

With respect to generating recognition codes and providing point use ticket identifying the generated recognition code. Walker teaches user generated traveler's checks (i.e. point use ticket) having completion codes (i.e. generated recognition code). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Ikeda, the teachings of Walker of generating recognition codes and providing point use ticket identifying the generated

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recognition code because such a modification would allow for **bearer notes including the generated code without the use having to travel to an issuer location** (Walker co. 1, lines 42-58).

With respect to claims 3, Ikeda further teaches means for subtracting the number of reserved points from the accumulated reserve points for the customer to record the added number of points as a new accumulated number of points in the point database (Figure 16).

### **Response to Arguments**

6. The Examiners wants to point out that in the final rejection mailed on 1/25/2008 contains a typo by referring to Shinichi. All the claims are rejected over Ikeda in view of Walker, all the citations and the Figures cited refer to both Ikeda and Walker.

Therefore, the arguments pertaining to Shinichi are moot.

7. Applicant argues that Ikeda doesn't teach determining whether a point use ticket is usable by verifying a reference request for a number of reserved points. The Examiner respectfully disagrees with Applicant because Ikeda clearly teaches determining whether a point is redeemable (i.e. point ticket is usable) by activating a program which performs a point process on the reserved points to be redeemed (see Figure 5 and col. 6, lines 6-17).

8. Applicant argues that Walker doesn't teach a recognition code issued by the point-service system for the arbitrary number of reserved points requested by the user.

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The Examiner wants to point out that applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Ikeda was cited for teaching a point service system (i.e. Online Shopping mall) for managing the requested number of points requested by the user). Walker was cited for using recognition codes (i.e. completion codes) on traveler's checks (i.e. point use ticket). The Examiner wants to point out that the combination of Ikeda and Walker teaches the claimed invention.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

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8/11/2008



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